

REMARKS

Claims 22 and 24-42 are now present in this application. Claims 22, 41 and 42 are independent. By this Amendment, claims 22, 29, 33 and 36 are amended and claim 23 has been cancelled without prejudice to or disclaimer thereof. No new matter is involved.

Reconsideration of this application, as amended, is respectfully requested.

ELECTION BY PREVIOUS PRESENTATION TRAVERSAL

The outstanding Office Action has restricted claim 42, and has withdrawn claim 42 from consideration on its merits because it is directed to an invention that is independent and distinct from that which was originally claimed. This restriction is respectfully traversed.

The reason given that claim 42 is independent and distinct from the originally claimed invention is that claim 42 recites a new combination of at least one connector/coupling, a rod, and a hook adapted to be fixed to the rod by attachment of an open tail of the hook directly to the rod (hook 115 having open tail 118 shown in Fig. 26) as a new element which has never been claimed and examined before.

Applicants respectfully submit that the Office Action does not establish that claim 42 is independent and distinct from the originally claimed invention, because originally filed claim 40 recites the dorsolumbar and lumbosacral vertebral fixation system, as in claim 22, wherein as a fixation element an open tail (118) hook (115) is used, as a top connection directly to the rod (112), being closed and attached by means of a locknut (120) and a locking setscrew (119).

Additionally, new claim 42 merely recites features from previously presented claim 40, which has been examined on its merits. In this regard, claim 40, which was examined on its merits in the Office Action dated September 3, 2009, clearly recited a dorsolumbar and lumbosacral vertebral fixation system as in claim 41, wherein an open tail hook is used for vertebral fixation, as a top connection directly to the rod, the open tail hook being closed and attached by means of a locknut and a locking setscrew. (emphasis added)

The attention of the Examiner is directed to the emphasized language of already examined claim 40, which clearly is the same language that is an issue in claim 42. In view of

this, Applicants respectfully submit that the Examiner's conclusion that the language of claim 42 has never been claimed and examined before is simply incorrect.

Furthermore, because the language of claim 42 has been previously presented, and examined before in the Office Action dated September 3, 2009, there is no serious burden on the Examiner to examine claim 42.

Accordingly, Applicants respectfully request that the restriction and election by previous presentation be withdrawn and, that claim 42 be examined on its merits in the next Office Action, which cannot properly be made a final rejection, for the reasons presented above.

Premature Final Rejection

Because claim 42 should have been examined on its merits in the outstanding Office Action, for reasons explained above, and will have to be examined on its merits in a new Office Action, the outstanding Office Action was improperly made a final Office Action.

Accordingly, withdrawal of the finality of the outstanding Office Action, and entry of this amendment as a matter of right, are respectfully requested

Rejections under 35 U.S.C. § 112

Claims 29, 33 and 36 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite. This rejection is respectfully traversed.

Claim 29 has been amended by deleting the word "it" in the last line of claim 29, and substituting "the at least one connector or coupling" therefor.

Claim 33 has been amended by deleting the language in issue.

Claim 36 has been amended to add a missing verb.

Applicants respectfully submit that the amendments to claims 22, 33 and 36 make the meaning of those claims clear and definite.

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Rejections under 35 U.S.C. § 102

Claims 22, 38, 39 and 41 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,562,662 to Brumfield. These rejections are respectfully traversed.

A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and *Hazani v. Int'l Trade Comm'n*, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed Cir. 1997). While, of course, it is possible that it is inherent in the operation of the prior art device that a particular element operates as theorized by the Examiner, inherency may not be established by probabilities or possibilities. What is *inherent*, must necessarily be disclosed. *See In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981); *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the Applicants are entitled to the patent. However, when a *prima facie* case is made, the burden shifts to the Applicants to come forward with evidence and/or argument supporting patentability. Patentability *vel non* is then determined on the entirety of the record, by a preponderance of evidence and weight of argument, *In re Gulag*, 62 USPQ2d 1151 (Fed. Cir. 2002).

Moreover, as stated in MPEP § 707.07(d), where a claim is refused for any reason relating to the merits thereof it should be "rejected" and the ground of rejection fully and clearly stated.

Additionally, findings of fact and conclusions of law by the USPTO must be made in accordance with the Administrative Procedure Act, 5 U.S.C. §706(A), (E) (1994). *See Zurko v. Dickinson*, 527 U.S. 150, 158, 119 S.Ct. 1816, 1821, 50 USPQ2d 1930, 1934 (1999).

A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present. *See Rosco v. Mirro Lite*, 304 F.3d 1373, 1380, 64 USPQ2d 1676 (Fed. Cir. 2002). The dispositive question regarding anticipation is whether one skilled in the art would reasonably understand or infer from the prior reference's teaching that every claim

feature or limitation was disclosed in that single reference, *Dayco Products, Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1368, 66 USPQ2d 1801 (Fed. Cir. 2003).

Brumfield does not disclose the combination of features recited in independent claim 22, as amended. As amended, claim 22 includes the subject matter of former (now canceled) claim 23, which has been indicated as containing allowable subject matter. For example, Brumfield fails to disclose the combination of features recited in amended claim 22, including wherein the at least one connector or coupling includes an annular body and two clamp elements and an open swivel inside of the annular body.

Nor does Brumfield disclose the features recited in amended independent claim 41, which also recites wherein the at least one connector or coupling includes an annular body and two clamp elements and an open swivel inside of the annular body.

Accordingly, claims 22, 38, 39 and 41 are not anticipated by Brumfield.

Reconsideration and withdrawal of this rejection are respectfully requested.

Rejection under 35 U.S.C. § 103

Claim 40 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Brumfield. This rejection is respectfully traversed.

Claim 40, as amended, depends from new claim 42. Both claims 40 and 42 positively recite a combination of features that is not rendered obvious by Brumfield. For example, as amended, claim 40 now recites that the open tail of the device for vertebral fixation is adapted to be attached to the rod and locked into place by a setscrew on the inside of the open tail and a locknut on the outside of the open tail, and the open tail hook has an opening and is adapted to receive the rod inside of its opening.

This combination of features is clearly not disclosed by Brumfield.

Accordingly, claim 40, as amended, clearly recites an invention which patentably defines over Brumfield.

Reconsideration and withdrawal of this rejection of claim 40 are respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot, and the election/restriction requirement has been properly traversed, and should be withdrawn. Additionally, as noted above, Applicants' Contingent Petition under 37 CFR § 1.181 and § 1.244 should be decided promptly by the Commissioner, and the restriction/election requirement withdrawn and all claims should be acted upon their merits in the next Office Action.

Applicants also respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46, 472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: December 14, 2010

Respectfully submitted,

By 

Paul C. Lewis

Registration No.: 43,368

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicants

PCL/RJW:kml 